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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/870,475 | 06/01/2001 | Toru Kurokawa | 0649-0786P | 1027 |
| 2292 | 7590 | 03/09/2005 | EXAMINER | |
| BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747 | | | HUNTSINGER, PETER K | |
| | | | ART UNIT | PAPER NUMBER |

2624

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/870,475

Applicant(s)

KUROKAWA, TORU

Examiner

Peter K. Huntsinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/1/01, 2/20/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 6-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Garfinkle et al. U.S. Patent 6,017,157.

Referring to claims 1 and 10, Garfinkle et al. disclose an order receiving server (image server 16 of Fig. 1, col. 3, lines 62-67, col. 7, lines 4-15), and a terminal unit (upload interface A of Fig. 1, col. 4, lines 21-33), when the recording medium (computer storage, col. 3, lines 56-58), storing a digital image data, a server-connection address information, and a designated print-order acceptant information, (col. 4, lines 60-65) is mounted to the terminal unit, said terminal unit is connected to said order receiving server based on said server-connection address information so as to transmit said designated print-order acceptance information and at least a part of said digital image data to said order receiving server (3f of Fig. 3, col. 4, lines 21-33); and further wherein said order receiving server (image server 16 of Fig. 1, col. 3, lines 62-67) outputs a print command data based on the received

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digital image data, and a command data by which an acceptant of an order in accordance with said designated print-order acceptant information can receive an image print that is printed based on said print command data (col. 7, lines 4-15).

Referring to claims 2, 11, and 17, Garfinkle et al. disclose an order receiving server that is a WWW server (col. 5, lines 1-10).

Referring to claims 3, 12, and 18, Garfinkle et al. disclose server-connection address information and designated print-order acceptant information (col. 4, lines 60-67) are recorded on said recording medium as URL data for specifying a WWW page created for each receiver of the order (col. 6, lines 5-13), and said terminal unit, after acquiring the data of the WWW page for each of said specified receivers of the order, transmits said digital image data to said WWW server (col. 9, lines 14-17).

Referring to claim 4, Garfinkle et al. disclose data of the WWW page for each of said specified receivers of the order includes data for acquiring data of a WWW page of another receiver than the receiver of the order according to said designated print-order acceptant information (col. 6, lines 5-14).

Referring to claims 7 and 13, Garfinkle et al. disclose server-connection address information and designated print-order acceptant information are recorded when the digital image data is recorded in said recording medium (col. 4, lines 60-67).

Referring to claims 8 and 14, Garfinkle et al. disclose designated print-order acceptant information is data that specifies a receiver of request to whom creation of said recording medium has been requested (5j of Fig. 5D, col. 7, lines 47-52).

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Referring to claims 9 and 15, Garfinkle et al. disclose server-connection address information and said designated print-order acceptant information are renewable (4c of Fig. 4, col. 8, lines 1-7).

Referring to claim 16, Garfinkle et al. disclose digital image data obtained by developing a photographic film before development and carrying out a photoelectrical conversion of the image after development, digital image data obtained by carrying out a photoelectrical conversion of the photographic film after development or an image of an image print, and digital image data recorded on other recording mediums is recorded on a single recording medium (col. 2, lines 53-64), and there is included a step of recording connection address data to a print order receiving server connected to a network, designated print-order acceptant information, and data for causing said terminal unit to connect to said order receiving server through said network (col. 4, lines 60-65) when the recording medium is mounted to a terminal unit and to transmit said designated print-order acceptant information to said order receiving server (3f of Fig. 3, col. 9, lines 21-33).

Referring to claim 19, Garfinkle et al. disclose designated print-order acceptant information is data that specifies a provider to whom provision of said recording medium is requested (col. 4, lines 60-65).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

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patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle et al. U.S. Patent 6,017,157 as applied to claims 1-5 above, and further in view of Fanning et al. U.S. Patent 6,742,023.

Referring to claim 5, Garfinkle et al. disclose the image print order system of claims 1-5 but do not disclose expressly accessing an alternative receiver when an acceptant cannot receive the order. Fanning et al. disclose accessing a different server whenever a file cannot be transferred from a server (col. 7, lines 49-65). Fanning et al. disclose the method of accessing a server through FTP (col.7-8, lines 66-68, 1-6), which is a protocol for accessing WWW pages and files. Garfinkle et al. and Fanning et al. are combinable because they are from the same field of electronic file transferring. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to allow the image print order system of Garfinkle et al. to access a website of another server whenever a server becomes unavailable. The motivation for doing so would have been to provide an alternative server for file transfer if one server becomes unavailable. Therefore, it would have been obvious to combine Fanning et al. with Garfinkle et al. to obtain the invention as specified in claim 5.

Referring to claim 6, Garfinkle et al. disclose the image print order system of claims 1-5 but do not disclose expressly accessing an alternative receiver when an acceptant cannot receive the order. Fanning et al. disclose accessing a different server whenever a file cannot be transferred from a server (col. 7, lines 49-65).

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Garfinkle et al. and Fanning et al. are combinable because they are from the same field of electronic file transferring. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to allow the image print order system of Garfinkle et al. to access a website of another server whenever a server becomes unavailable. The motivation for doing so would have been to provide an alternative server for file transfer if one server becomes unavailable. Therefore, it would have been obvious to combine Fanning et al. with Garfinkle et al. to obtain the invention as specified in claim 5.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (703)306-4088. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PKH

A handwritten signature in black ink, consisting of a large, stylized 'P' followed by a long, sweeping horizontal line that extends across the page.